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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/723,522	11/27/2000	Philip M. Parker	032031.0002.UTL	4892
20985	7590	06/22/2004	EXAMINER	
FISH & RICHARDSON, PC 12390 EL CAMINO REAL SAN DIEGO, CA 92130-2081			NGUYEN, DANG T	
			ART UNIT	PAPER NUMBER
			2178	

DATE MAILED: 06/22/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/723,522

Applicant(s)

PARKER, PHILIP M.

Examiner

Dang T Nguyen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 April 2004.
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-31 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1-31 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☒ The drawing(s) filed on 27 November 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

1. This office action is in response to applicant amendment received on 04/13/04. Independent claims 1, 26, 29, and dependent claims 1, 16, 29, 30, and 31 have been amended. Claims 1 – 31 are pending on this application.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-2, 5-10, 14-19, 22-27, and 29-30 remain rejected under 35

U.S.C. 102(b) as being anticipated by Maegawa, U.S. patent No. 5,966,386 – filed Mar. 4, 1997.

Regarding independent claims 1 and 16, Figure 1 of Maegawa discloses a computer-based method and system of authoring original title material (Fig. 20 [73]), comprising the steps of: providing an automation program, macro or module (Fig. 20 [73]); and automatically authoring (Fig. 20 [20a: Consumer Module], Col. 15 lines 59 – 60), using a computer (Fig. 13 [20]), an original title material (Col. 19 lines 41 – 44) derived from at least one database file (Fig. 20 [82]) using said automation program, macro, or module (Fig. 20 [73, 20a]).

Regarding dependent claims 2 and 17, Maegawa further discloses comprising: automatically distributing said title material to a second computer (Fig. 20 [32a]) over a system of networked computers (Fig. 1).

Regarding dependent claims 5 and 22, Maegawa further discloses comprising: automatically authoring meta material relating to said title material (Col. 19 lines 41 – 44 for disclosing meta data “content data” related to title data) and (Col. 4 lines 41- 46).

Regarding dependent claims 6 and 23, Maegawa further discloses comprising: automatically distributing meta material to a second computer over a system of networked computers (Fig. 1 disclosing meta data distributing to multiple notes (computers) 20, 16, 30, 14, 32, 12 over a system network) and (see Figs. 16-20).

Regarding dependent claims 7 and 24, Maegawa further discloses comprising: automatically authoring marketing material relating to said title material (Col. 19 line 42 “advertisement”).

Regarding dependent claims 8 and 25, Maegawa further discloses: automatically distributing said marketing material to a second computer over a system of networked computers (Fig. 17, Col. 18 lines 7-18).

Regarding dependent claims 9 and 26, Maegawa further disclosing automatically authoring control material (Fig. 2 [328,330]) and (Fig. 20 [73] for disclosing authoring controlling data “content data”) relating to said title material (Col. 9 lines 38- 46) and (Col. 19 lines 40 - 44).

Regarding dependent claim 10, Maegawa further discloses comprising:
automatically distributing said control material (Col. 9 lines 41-46) and (Col. 19 lines 40 - 44).

Regarding dependent claim 14, Maegawa further discloses comprising
automatically authoring a plurality of title materials (Fig. 20 [73] for disclosing plurality of title data output) derived from said at least one database file (Fig. 20 [32a]) using said automation program, macro, or module (Fig. 20 [20a]).

Regarding dependent claim 15, Maegawa discloses wherein said step of
automatically authoring occurs in response to a request to obtain said title material by a recipient (Fig. 15, Col. 17 lines 40-45).

Regarding dependent claim 18, Maegawa discloses wherein said title material
is sold (Col. 9 lines 38-50) via said second computer over said system of networked computers to an end-user (Fig. 17).

Regarding dependent claim 19, Maegawa discloses wherein said system of
networked computers is the Internet (Fig. 17 [800], Col. 18 lines 7-9).

Regarding dependent claims 27, Maegawa further discloses comprising: meta
material (Col. 19 line 41 "multimedia content data", Fig. 20 [Content Data]) relating to
said title material (Col. 19 line 42 "title data", Fig. 20 [Title Data]) wherein said meta
material is automatically authored by said computer (Fig. 20 [20a]) and automatically
distributed to a second computer by said computer over system of networked
computers (Fig. 20 [83]); marketing material (Col. 19 lines 40-42 "advertisement")
relating to said title material, wherein said marketing material is automatically authored

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by said computer (Fig. 20 [20a] Col. 19 lines 40 - 45) and automatically distributed to said second computer by said computer over said system of networked computers (Fig. 17, Col. 18 lines 4-19); control material relating to said title material (Col. 19 line 43), wherein said control material is automatically authored by said computer (Col. 19 lines 41 - 45); and a recipient, wherein said recipient purchases said title material via said second computer over said system or networked computers (Fig. 17, Col. 18 lines 7 - 18).

Regarding dependent claims 29, Fig. 20 [73] of Maegawa discloses a computer based method of authoring an original book or literary work (Fig. 20 [Title Data]) comprising the steps of: providing an automatically program, macro or module (Fig. 20 [20a], Col. 15 lines 55 – 60); automatically authoring (Col. 19 lines 40 – 45), using a computer (Fig. 13 [20] disclosing a computer of Fig. 20[20a]), an original book or literary work (Fig. 20 [Title Data]) derived from at least one database file (Fig. 20 [32a]) using said automatic program, macro, or module (Fig. 20 [20a]); automatically authoring meta material (Fig. 20 [Content Data]), wherein said meta material relates to said original book or literary work (Col. 19 lines 40 – 45); automatically distributing said original book or literary work, and automatically distributing said meta material (See Figs.1, 17, 20 for distributing data over network).

Regarding dependent claim 30, Maegawa further discloses comprising: automatically authoring marketing material, wherein said marketing material relates to said original book or literary work (Col. 19 line 42 “advertisement”).

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 3, 20, and 31 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Maegawa, U.S. Patent No. 5,966,386 - filed (03/4/97) in view of Yamane et al., U.S. Patent No. 6,393,196 B1, filed (9/26/97).

Regarding dependent claims 3, 20, and 31, Maegawa as applied to claims 1, 16, and 29 above, disclose every aspect of applicant's claimed invention except for authoring original title material or literary work in more than one language.

Fig. 2 of Yamane et al. discloses an authoring system having title material in more than one language (Col. 13 lines 22 – 23).

Maegawa and Yamane et al. are analogous because both relating to authoring system for title of data, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the title authoring system of Maegawa with multiple languages title authoring system of Yamane et al. for the purpose of providing to the user the selection of languages of interests (Yamane, Col. 13 lines 32 – 33).

Claims 4 and 21 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Maegawa, U.S. Patent No. 5,966,386 - filed (03/4/97) in view of Foreman et al., U.S. Patent No. 6,628,303 B1, filed (7/29/96).

Regarding dependent claims 4 and 21, Maegawa as applied to claims 1, and 16, above disclose every aspect of applicant's claimed invention except for saving the title material in at least two formats.

Fig. 14 of Foreman discloses an authoring system for video in a computer system having saving [260] title material [250] in at least two formats (Col. 16, lines 57 – 64).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to apply the saving the title material in multiple formats taught by Foreman to the title material of Maegawa for the purpose of providing flexibility format in multimedia systems (Foreman, Col. 16 lines 58 - 59).

Claims 11 - 13 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Maegawa, U.S. Patent No. 5,966,386 - filed (03/4/97) in view of Saigh et al., U.S. Patent No. 6,633,877 B1, filed (9/26/2000).

Regarding dependent claims 11 - 13, Maegawa as applied to claims 1, 11, and 12 above, disclose every aspect of applicant's claimed invention except for wherein said title material comprises a work that is capable of being associated with a unique identification alpha-numeric code; and wherein said code comprises an ISBN code, an ISSN code, a UPC number, or an SKU code, and wherein said title material comprises a written publication.

Fig. 2 of Saigh et al. discloses publishing distribution system having title material comprises a work that is capable of being associated with a unique identification alpha-

numeric code; and wherein said code comprises an ISBN code, an ISSN code, a UPC number, or an SKU code, and wherein said title material comprises a written publication (Col. 6 lines 26 – 28).

Maegawa and Saigh et al. are analogous because both related to authoring published distribution system, It would have been obvious to one have ordinary skill in the art at the time the invention was made to apply the title written publication by ISBN code taught by Saigh et al. to the title written publication of Maegawa for the purpose of providing alpha-numeric international communication network which is provided by ISBN (Saigh, Col. 6 lines 26 – 28).

Claim 28 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Maegawa, U.S. Patent No. 5,966,386 - filed (03/4/97) in view of Brodersen et al., U.S. Patent No. 6,453,459 B1, filed (1/21/1998).

Regarding dependent claim 28, Maegawa as applied to claim 16 above, discloses every aspect of applicant's claimed invention except for a template, wherein said template is used to author a plurality of title materials using said automation program, macro, or module, wherein said plurality of title materials are to be commercially available.

Fig. 1 of Brodersen et al. discloses an authoring movie titles (Col. 5 lines 13 – 14) for distribution through network I/O 145 (Col. 5 lines 45 – 52) having for a template (Fig. 3), wherein said template is used to author a plurality of title materials (Col. 7 lines 23 –

37) using said automation program, macro, or module (Fig. 1[160]), wherein said plurality of title materials are to be commercially available (Col. 5 lines 49 – 52).

Maegawa and Brodersen are analogous because both related to authoring system for distribution network. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have the template of authoring system taught by Brodersen et al. to the authoring system of Maegawa for the purpose of providing authoring system having integrated interface for storing, recalling authoring information, simulator for viewing progressive, and comparative authored movie titles prior to compiling, and for viewing authored movie titles after compiling (Brodersen, Col. 3 lines 40-49).

Response to Arguments

4. Applicant's arguments filed on 04/13/04 have been fully considered but they are not persuasive.

First, applicant argues that Meagawa requires "input from a consumer – nothing is automatically authored, using a computer." (Under Remarks, on page 9 lines 18 – 20, and page 10, lines 3 – 6, and lines 16 – 20, with respect to the amended claims 1, 16 and 29). Examiner respectful traverses from the following:

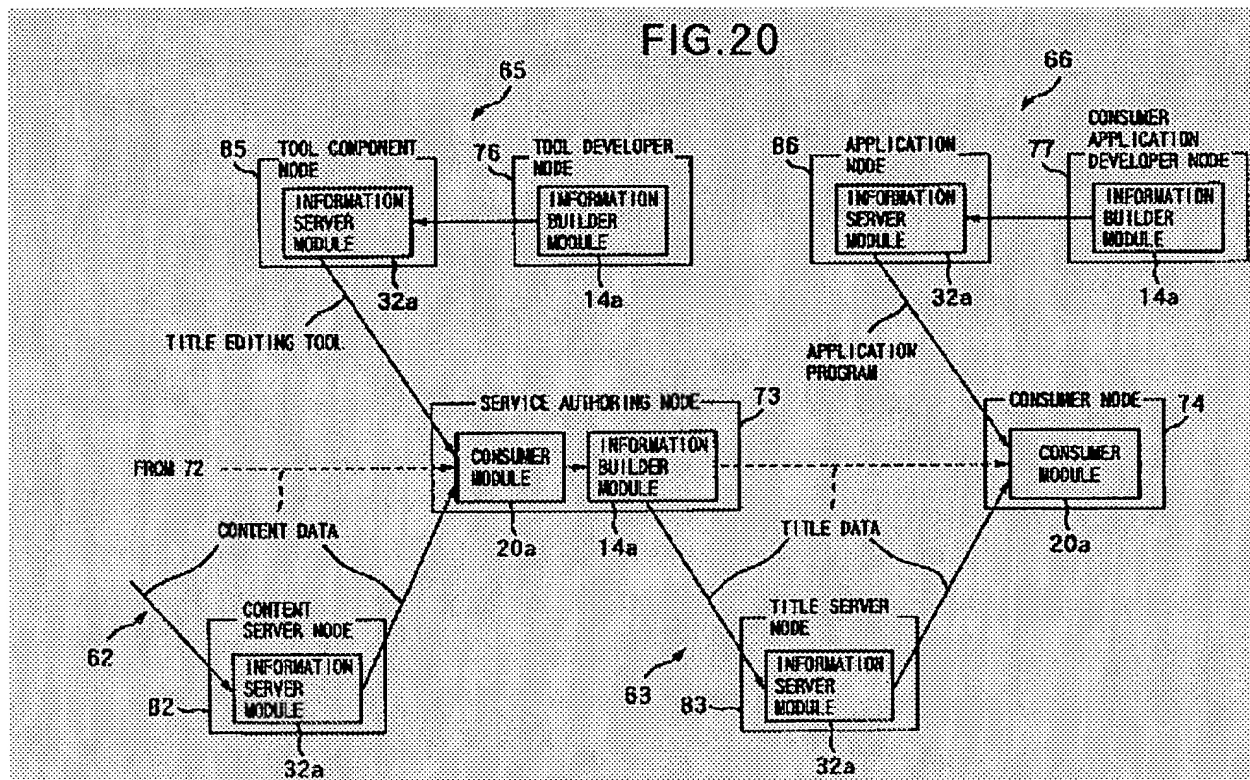


Fig. 20 [73] of Meagawa discloses an service authoring node having an consumer module 20a to generate a title data from received content data (Col. 19 lines 41 - 44), and on Col. 15 lines 59 – 60 Maegawn further discloses wherein the consumer module 20 is operating automatically. Therefore, the consumer module 20 of authoring node 73 does not require any manually operation to create the title data, and Maegawn clearly teaches an automatic authoring system to generate a title data.

Second, applicant asserts that Maegawn does not author “original title” (Under Remarks, on page 10 lines 8 – 15, and page 11, lines 1 - 3, with respect to the amended claims 1, 16 and 29). Examiner respectful traverses from the following:

Fig. 20 [73] of Maegawn discloses a service-authoring node having a consumer module 20a to generate a title data from received content data (Col. 19 lines 41 - 44). Even though Maegawn does not explicitly disclose the "title data" which is an "original title"; however, the "original title" is clearly anticipated from the "title data" of Maegawn, because there is only one of "title data" is generated from the authoring node 73 from the input content data and authoring node 73 is only one place to generate the "title data". Therefore, the "title data" generated from the input contain data is an "original title data".

Third, applicant argues that "Maegawa fails to teach the claim limitations of claim 1, 16 and 29, therefore Maegawa in combination with Yamane, Foreman, Saigh, or Brodersen fails to teach all the limitations of the claims" (on pages 11 and 12 under Response to Claim Rejection under 35 USC §103 with respect to claims 3 – 4, 11 – 13, 20 – 21, 28 and 31 as claims rejected under §103 all depend from claims 1, 16, and 29). Examiner respectfully traverses, because Maegawa as response and applied to claims 1, 16, and 29 above, disclose each and every limitation of claims 1, 16 and 29. Therefore, obviousness from Yamane, Foreman, Saigh or Brodersen as applied to claims 3 – 4, 11 – 13, 20 – 21, 28 and 31 disclosed each and every limitation of the claims invention.

Conclusion

5. THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Contact Information

6. Any inquiry concerning this communication from the examiner should be directed to Dang Nguyen, who can be reached by telephone at (703) 305-1673. Normal contact times are M-F, 8-4:30.

Upon an unsuccessful attempt to contact the examiner, the examiner's acting supervisor, Heather Herndon, may be reached at (703) 308-5186.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist, whose telephone number is (703) 305-3900.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks
Washington, D.C. 20231

Or faxed to:

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(703) 746-7239 (for formal communications intended for entry)

or:

(703) 746-7238 (for after-final communications)

Hand-delivered responses should be brought to

Crystal Park II, 2121 Crystal Drive

Arlington, VA, Fourth Floor (receptionist).

Dang Nguyen 6/10/2004



STEPHEN S. HONG
PRIMARY EXAMINER